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**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/011,797 07/23/98 PARMENTIER M VANMA72.001A

HM22/1120

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620 NEWPORT CENTER DRIVE  
SIXTEENTH FLOOR  
NEWPORT BEACH CA 92660

EXAMINER

MURPHY, J

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

11/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/011,797

Applicant(s)

PARMENTIER ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 35-42, 47-52, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 48-52, 57-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-42 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
- ☐ received.
  - ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
  - ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 35-38 and 40 were amended in Paper no. 9, 9/5/2000.

Claims 35-42 and 47 are under consideration.

The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office Action.

### ***Response to Amendment***

The rejection of claim 40 under 35 USC § 112, first paragraph for recitation of ORL1 has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claims 35-37, 40 and 47 under 35 USC § 112, second paragraph has been obviated by Applicant's amendment, and is thus withdrawn,

The rejection of claim 37 under 35 USC § 102(b) has been obviated by Applicant's amendment, and is thus withdrawn.

### ***Claim Rejections - 35 USC § 112, first paragraph***

Claim 38 stands rejected, and amended claims 35-36 and 47 are rejected, under 35 USC § 112, first paragraph, for reasons of record set forth in Paper No. 8, 3/29/2000, because the specification, while being enabling for a substantially purified polypeptide comprising an amino acid selected from the group consisting of SEQ ID NOs: 2, 3 and 4, does not reasonably provide enablement for an isolated peptide encoded by a polynucleotide which corresponds to at least

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70% or 90% of the SEQ ID NO: 1 or its complementary strand. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

As was set forth in both the Mikayama et al. and Voet et al. references cited in the previous Office action, Paper No. 8, 3/29/2000, even single amino acid changes can radically alter protein function. Applicant has not provided any guidance as to which amino acids may be altered while maintaining peptide function as a ligand of ORL1. As the Wands analysis set forth in the previous Office action, Paper No. 8, 3/29/2000, has demonstrated, it would require undue experimentation for one of ordinary skill in the art to make and use the claimed invention. Claim 47 is rejected insofar as it depends on the recitation in claim 35 of "70% identical".

### ***Claim Rejections - 35 USC § 112***

Claims 35-42 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "like" in claims 35 and 40 is a relative term which renders the claim indefinite. The term "like" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 36-39, 41-42 and 47 are rejected insofar as they depend on the recitation of the term "like".

### ***Conclusion***


Claims 35-42 and 47 are rejected.

***Advisory Information***

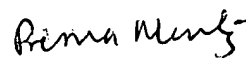
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
November 15, 2000

  
**PREMA MERTZ**  
**PRIMARY EXAMINER**